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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,450	11/25/2003	John J. Breen	16356.827 (DC-05388)	7118
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EXAMINER				
O'NEILL, KARIE AMBER				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
09/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/721,450

**Applicant(s)**

BREEN ET AL.

**Examiner**

Karie O'Neill

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-54 is/are pending in the application.
- 4a) Of the above claim(s) 29-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 13, 2008, has been entered.

Claim 51 has been amended. Claims 29-50 have been withdrawn from consideration as being drawn to a non-elected invention. Therefore, Claims 51-54 are pending in this office action.

### ***Claim Rejections - 35 USC § 102***

2. The rejection of Claims 51-52 under 35 U.S.C. 102(e) as being anticipated by Kunimoto et al. (US 7,160,643 B2) have been overcome based on the amendments to the claims and the arguments presented on pages 8-10 of Remarks dated July 15, 2008.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 51 and 53-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al. (US 16,191,941B1).

With regard to Claim 51, Ito et al. discloses in Figures 1-3, a battery powered device (100), comprising: a chassis, or body (2); a battery bay, or back end (2F) of the body; and a battery assembly, called a battery pack (200), the battery assembly (200) comprising a plurality of battery subassemblies (210, 220) that are operable to be mechanically mated and electrically coupled together to form the battery assembly (200) (column 6 lines 47-49), the plurality of battery subassemblies (210, 220) comprising: a first subassembly, called a short battery portion (210), including a first plurality of batteries and having a mating surface member, called hinge recesses (211), including a first pattern for mating engagement with a second subassembly, called a long battery portion (220), including a second plurality of batteries and having a mating surface member, called hinge fitted protrusions (221), including a second pattern, which is an inverse pattern to the first pattern, the patterns, or hinges (211, 221) supporting battery cells within the subassemblies (210, 220) and also resisting relative movement between the first and second subassemblies (210,220) when the mating surfaces are engaged to form the battery assembly (column 6 lines 66-67 and column 7 lines 1-10). Claim 51 is drawn to a product, i.e. a battery powered device. The phrase "being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt

by the user to avoid increased shipping fees" is considered functional language and imparts intended use to the product. Therefore, while the intended use language of the claim has been considered, it is not given patentable weight because it is directed to a process and not directed to the structural features of the product. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2111. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. See MPEP 2113.

With regard to Claims 53-54, Ito et al. discloses in Figures 4, 5 and 23, the battery powered device (100) being a portable computer including a central processing unit (35) located within the device housing body (2) (column 10 lines 8-11).

5. Claims 51-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Perkins et al. (US 2004/0157116 A1).

With regard to Claim 51, Perkins et al. discloses in Figures 1-4, a battery powered device (14), comprising: a chassis, called a housing (14a); a battery bay, called a battery holding regions (22a', 22a", 22c', 22c") formed in the chassis (14a); and a battery assembly (18), the battery assembly (18) comprising a plurality of battery subassemblies (18a, 18c) that are operable to be mechanically mated and electrically

coupled together to form the battery assembly (paragraphs 0031-0032), the plurality of battery subassemblies (18a, 18c) comprising: a first subassembly (18a) including a first plurality of batteries (paragraphs 0031-0032) and having a mating surface member which fits in to the first battery bays (22a', 22a") including a first pattern for mating engagement with a second subassembly (18c) including a second plurality of batteries (paragraphs 0031-0032) and having a mating surface member including a second pattern, which is an inverse pattern to the first pattern, the patterns supporting battery cells within the subassemblies and also resisting relative movement between the first and second subassemblies when the mating surfaces are engaged to form the battery assembly (paragraphs 0033-0037). Perkins et al. discloses the battery pack (18) including linear portions (18a, 18c) containing a plurality of batteries aligned end to end, being placed into the battery bays (22a', 22a", 22c', 22c") and having an intermediate recess region (22b) between the battery bays to interface with the battery bays and electrically and mechanically coupling the battery subassemblies (18a, 18c) to one another as well as to engage the mating surfaces of the battery subassemblies (18a, 18c). Claim 51 is drawn to a product, i.e. a battery powered device. The phrase "being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt by the user to avoid increased shipping fees" is considered functional language and imparts intended use to the product. Therefore, while the intended use language of the claim has been considered, it is not given patentable weight because it is directed to a process and not directed to the structural features of the product. While features of an apparatus may be recited either structurally or functionally, claims

directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2111. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. See MPEP 2113.

With regard to Claim 52, Perkins et al. discloses wherein the first battery subassembly (18a) exhibits a first cell chemistry and the second battery subassembly (18c) exhibits a second cell chemistry, wherein the first cell chemistry is different from the second cell chemistry, the different cell chemistries being nickel-cadmium and/or nickel-metal hydride as well as other types of rechargeable batteries known in the art (paragraph 0031).

With regard to Claims 53-54, Perkins et al. discloses wherein the battery powered device (14) comprising an information handling system including a processor and a memory coupled to the processor, all located within the chassis, or housing (14a) of the device (14) (paragraph 0030).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 51-54 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karie O'Neill whose telephone number is (571)272-8614. The examiner can normally be reached on Monday through Friday from 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karie O'Neill  
Examiner  
Art Unit 1795

KAO

/Mark Ruthkosky/

Primary Examiner, Art Unit 1795